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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/800,295

03/12/2004

Scott F. Singer

04-225

8245

39310 7590 08/25/2009  
MBHB/TRADING TECHNOLOGIES  
300 SOUTH WACKER DRIVE  
SUITE 3200  
CHICAGO, IL 60606

EXAMINER

LIU, CHIA-YI

ART UNIT

PAPER NUMBER

3696

NOTIFICATION DATE

DELIVERY MODE

08/25/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mbhb.com  
williamsd@mbhb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/800,295	<b>Applicant(s)</b> SINGER ET AL.	
	<b>Examiner</b> CHIA-YI LIU	<b>Art Unit</b> 3696	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to an amendment submitted 4/28/2009. Applicant has amended Claims 28, 37-39 and 48-49. After careful consideration of Applicant's amendments and arguments, new grounds of rejections for Claims 28-49 have been established as set forth in detail below.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "identifying a long or short position taken by a user with respect to a tradable object, wherein a long position is associated with a quantity of the tradable object that has been bought by the user at a price, and wherein a short position is associated with a quantity of the tradable object that has been sold by the user at a price," "computing a plurality of values based on the long or short position, wherein each of the plurality of values represent a profit or loss if the long or short position is closed at a price level," and "the first value represents a profit or loss incurred by the user if the long or short position is closed at the particular price." Applicant's originally filed

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specification only teaches "profit and loss values that represent the gross profit acquired if a tradable object is sold at the associated price", see page 30, lines 8-15 of Applicant's specification, and mentions nothing about "displaying indicator that correspond to a value that represents profit or loss incurred by a user if a long or short position is closed at a particular price" or even anything about "taking long and short position". Many dependent claims also have limitations associated with "long and short position" which are not described in the original specification. Removal of all the new matters is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "short position" in claims 28-49 are used by the claim to mean "selling one lot of tradable object" (as explained by the applicant in the remark sent 4/28/2009, Page 9- (e)), while the accepted meaning of "short position" is "a market position in which the investor has sold a financial instrument that he or she did not previously own, with the expectation of a decrease in value." The terms are indefinite because the specification does not clearly redefine the term.

Claims 28-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the applicant meant by "a profit or loss incurred by the user if the long or short position is closed at the particular price."

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(Closed position means the position is no longer available. It is unclear how profit and losses result from not able to buy and sell stocks. If a position is closed, there should not be any profit or loss because a person is unable to buy and sell.) Appropriate correction is required.

### **Response to Arguments**

Applicant argues that “when a trader sells one lot of a tradable object at a specific price”, it means a short position is established and therefore all of applicant’s added limitations regarding “long and short position” are not new matter. The Examiner disagrees. A short position means “the sale of a borrowed security, commodity or currency with the expectation that the asset will fail in value.” For example, an investor who borrows shares of stock from a broker and sells them on the open market is said to have a short position in the stock. Even though applicant’s specification teaches profits and loss, the specification does teach that the profit and loss is caused by taking “long and short positions” in stock and mentions nothing about “identifying a long or short position taken by a user with respect to a tradable object, wherein a long position is associated with a quantity of the tradable object that has been bought by the user at a price, and wherein a short position is associated with a quantity of the tradable object that has been sold by the user at a price,” “computing a plurality of values based on the long or short position, wherein each of the plurality of values represent a profit or loss if the long or short position is closed at a price level,” and “the first value represents a profit or loss incurred by the user if the long or short position is closed at the particular price.” It appears from Applicant's Specification (see at least page 30) that the profit/loss of Applicant's invention is calculated by the difference between buying price and the selling price (when the object is later sold to others). The specification does not teach “selling financial instrument that the seller does not own at the time of sale” (short position) or “displaying indicator that present profit/loss if a long/short position is closed

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(no longer available) at a particular price.” Therefore, Applicant’s argument is not persuasive.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHIA-YI LIU whose telephone number is (571)270-1573. The examiner can normally be reached on Mon-Thur alternating Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, TOM DIXON can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/  
Supervisory Patent Examiner, Art Unit 3696

CHIA-YI LIU  
Examiner  
Art Unit 3696